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1638

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Meir EDELMAN et al

Application No.: 09/529,172 Conf. No.1629

Filed: September 11, 2000

For: TRANSGENIC LEMNACEAE

Art Unit: 1638

Examiner: Ashwin D. Mehta

Washington, D.C.

Atty.'s Docket: EDELMAN=1

Date: July 15, 2003





THE COMMISSIONER OF PATENTS
2011 South Clark Place
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

Transmitted herewith is a [XX] Amendment [XX] Request for Interference Under 37 CFR §1.607 in the above-identified application.

[ ] Small Entity Status: Applicant(s) claim small entity status. See 37 C.F.R. §1.27.

[ ] No additional fee is required.

[XX] The fee has been calculated as shown below:

| | (Col. 1) CLAIMS REMAINING AFTER AMENDMENT | | (Col. 2) HIGHEST NO. PREVIOUSLY PAID FOR | (Col. 3) PRESENT EXTRA EQUALS | SMALL ENTITY RATE | SMALL ENTITY ADDITIONAL FEE | OR | OTHER THAN SMALL ENTITY RATE | OTHER THAN SMALL ENTITY ADDITIONAL FEE |
|---|---|---|---|---|---|---|---|---|---|
| TOTAL | * 43 | MINUS | ** 61 | 0 | x 9 | $ | | x 18 | $ |
| INDEP. | * 7 | MINUS | *** 12 | 0 | x 42 | $ | | x 84 | $ |
| FIRST PRESENTATION OF MULTIPLE DEP. CLAIM | | | | | + 140 | $ | | + 280 | $ |
| | | | | | ADDITIONAL FEE TOTAL | $ | OR | TOTAL | $ |

* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.

*** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

[XX] Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

[XX] It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

| Small Entity | | Other Than Small Entity | |
|---|---|---|---|
| Response Filed Within | | Response Filed Within | |
| [ ] First | - $ 55.00 | [ ] First | - $ 110.00 |
| [ ] Second | - $ 205.00 | [ ] Second | - $ 410.00 |
| [ ] Third | - $ 465.00 | [XX] Third | - $ 930.00 |
| [ ] Fourth | - $ 725.00 | [ ] Fourth | - $ 1450.00 |
| Month After Time Period Set | | Month After Time Period Set | |

[ ] Less fees ($_____) already paid for ___ month(s) extension of time on _____.

[ ] Please charge my Deposit Account No. 02-4035 in the amount of $_____.

[XX] Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of $ 930.00.

[ ] A check in the amount of $_____ is attached (check no. ).

[XX] The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant(s)

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

| | | |
|---|---|---|
| | | Atty. Docket: EDELMAN=1 |
| In re Application of: | ) | Conf. No.: 1629 |
| Meir EDELMAN | ) | Art Unit: 1638 |
| Appln. No.: 09/529,172 | ) | Examiner: Ashwin D. Mehta |
| Filed: September 11, 2000 | ) | Washington, D.C. |
| For: TRANSGENIC LEMNACEAE | ) | July 15, 2003 |

**REQUEST FOR INTERFERENCE UNDER 37 CFR §1.607**

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

Pursuant to 37 CFR §1.607, applicants hereby request to have an interference declared between the above-identified application and U.S. patent 6,040,498. The requirements of 37 CFR §1.607(a) will be fulfilled in the following sections which correspond to the sub-sections of 37 CFR §1.607(a).

(1) The patent is identified as Stomp et al patent no. 6,040,498, which patent is assigned on its face to North Carolina State University.

(2) The proposed count is:

Claims 1, 20 or 30 of U.S. patent 6,242,596

or

Claims 65, 66 or 67 of application 09/529,172.

(3) All of claims 1-65 of patent 6,040,498 correspond to the proposed count.

(4) At least claims 1, 12, 55 and 65-67 of the above-identified application correspond to the proposed count.

Application claims 65-67 correspond exactly to the second paragraph of the bifurcated proposed count.

Application claim 1 corresponds to the proposed count as it is a broader claim that encompasses the subject matter of application claim 66, which corresponds exactly to the count. They are drawn to the same patentable invention, as each would be obvious over the other if the other were available to the prior art (37 CFR 1.601(n)). The product-by-process limitation of an *Agrobacterium* mediated method in application claim 66 does not affect the scope of the claim and integration into the chromosome is required for genetic stability, so the scope of application claims 1 and 66 are substantially the same.

Application claim 12 corresponds to the count as it too is broader than and fully encompasses application claim 65, which corresponds exactly to the count. The recitation of *Lemnaceae* plants in application claim 65 is not patentably distinct from the recitation of *Lemnaceae* whole plants, plant tissue or callas in application claim 12. None of the other differences are

substantial. Thus application claim 12 is directed to the same invention as application claim 65.

Application claim 55 has slightly different wording but is substantially the same as the wording of application claim 67, which corresponds exactly to the count. Thus, claim 55 also corresponds to the count.

Patent claims 2-17, 42-57, 64 and 65 correspond to the count as none are patentably distinct from patent claim 1, which corresponds exactly to the count. Once the basic method of patent claim 1 is known, then the added features of the dependent claims or of independent patent claim 48 and those claims dependent therefrom would all have been obvious therefrom.

Patent claims 18, 19, 21-29, 40, 41 and 58-61 all correspond to patent claim 20, which itself corresponds exactly to the count. Each of said claims are drawn to stably transformed duckweed plant or tissue, adding additional limitations, each of which would have been obvious if patent claim 20 were assumed to be prior art. Thus, each correspond to the count.

Claims 31-39, 48-57 and 65 are all patentably indistinct from patent claim 30, which corresponds exactly to the count. Accordingly, each of said claims also correspond to the count.

(5) Application claims 1, 12 and 55 identified as corresponding to the count have previously been in the application, and, thus, the terms of same need not be applied to the disclosure of the application pursuant to 37 CFR §1.607(a)(5). Claims 65-67 have been presented on even date herewith. The following table applies the terms of these claims to the disclosure of the application.

| Terms of the Claim | Terms of the Disclosure |
|---|---|
| 65. A method for the stable genetic transformation | Page 3, lines 25-26 |
| of *Lemnaceae* | Page 4, lines 2-3 |
| plant tissue, comprising: | Page 4, lines 6-7 |
| inoculating *Lemnaceae* tissue with *Agrobacterium* | Page 30, lines 6-3 from the bottom |
| containing a transforming DNA molecule | Page 3, lines 27-30 |
| having a heterologous DNA of interest; and | Page 3, line 17 |
| co-cultivating the tissue with the *Agrobacterium* | Page 30, line 2 from the bottom, to page 31, line 2 |
| to produce the stably transformed *Lemnaceae* tissue. | Page 12, lines 29-32 |
| 66. A genetically stable *Lemnaceae* plant | See claim 1 as originally filed and page 3, lines 25- |
| comprising a heterologous DNA of interest | Page 3, line 17 |
| integrated into the chromosome, | Page 4, line 2 and page 34, lines 28-30 |

| Terms of the Claim | Terms of the Disclosure |
|---|---|
| wherein said plant is produced via an *Agrobacterium*-mediated method. | Page 5, lines 11-12 |
| 67. A method of production of a product of interest, comprising: | See claim 54 as originally filed |
| culturing a stably transformed *Lemnaceae* plant | Page 4, lines 22-23 |
| that expresses at least one heterologous product; and | Page 3, line 17, page 4, lines 19-20 and page 5, lines 7-9 |
| isolating and purifying said at least one heterologous product. | Page 4, lines 23-24 |

(6) The Stomp et al patent issued on March 21, 2000. At least application claims 1, 12 and 55, which have been shown to correspond to the count hereinabove, were first presented prior to March 21, 2001, therefore satisfying 35 USC 135(b).

In accordance with 37 CFR §1.607(b), it is requested that examination of this application be conducted with special dispatch within the Patent and Trademark Office. Furthermore, in accordance with 37 CFR §1.607(d), it is requested that a notice that an applicant is seeking to provoke an interference with the patent be placed in the file of the patent and a copy of the notice sent to the patentee without identifying the present applicants.

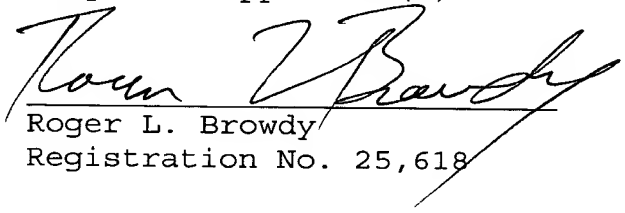
**STATEMENT UNDER 37 CFR §1.608 (a)**

The present application is a §371 national stage application of PCT/IL98/00487 filed October 8, 1998, which is a continuation in part of PCT/IL97/00328, filed October 10, 1997. Claims 1, 12 and 55 of PCT/IL97/00328 are the same as claims 1, 12 and 55 of the present application as originally filed. Thus, the effective filing date of the present application is October 10, 1997.

The Stomp et al patent 6,040,498 claims an earliest effective filing date of August 12, 1997. Thus, the effective filing date of the present application is three months or fewer after the effective filing date of the patent. In order to comply with 37 CFR §1.608(a), the undersigned hereby states that there is a basis upon which the applicants are entitled to a judgment relative to the patentee.

Accordingly, it is requested that, following the determinations required therein, an interference be declared in accordance with 37 CFR §1.607(b).

Respectfully submitted,
BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant(s)

By 
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